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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,612	11/13/2000	Duy H. Hua	90-99	9612

23713 7590 04/11/2002

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5370 MANHATTAN CIRCLE
SUITE 201
BOULDER, CO 80303

EXAMINER

FAY, ZOHREH A

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 04/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/712,612

Applicant(s)
Hu et al.

Examiner
Zohreh Fay

Art Unit
1614



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, claims 1-7, drawn to a method of treating a symptom or condition results from the activity of aldose reductase using the compounds claimed, classified in class 514, subclass 291, 292 and 912.

Group II, claims 8-14, drawn to a method of inhibiting aldose reductase activity in cells, using the claimed compounds, classified in class 514, subclass.

Group III, claims 15-18, drawn to a method of treating retinopathy, using the claimed compounds, classified in class 514, subclass 291, 292 and 912.

Group IV, claim 19, drawn to a method of decreasing the loss of PKC in diabetic patients using the compounds of claim 1, classified in class 514, subclass 291, 292 and 912.

Group V, claim 20, drawn to a method of inhibiting polyol accumulation in diabetic patients using the compounds of claim 1, classified in class 514, subclass 291, 292 and 912.

Group VI, claims 21-23, drawn to a pharmaceutical composition and a compound of claim 1, classified in class 514, subclass 291, 292 and 912.

The above-delineated inventions are independent and patentably distinct each from the other. Each of the above groups is drawn to totally different subject matter. One practicing the invention of one of the above groups would not necessarily be required to practice the invention of any of the other groups. The search for the above groups would not be co-extensive, particularly as to the literature search required. Each

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of the above compounds is capable of supporting its own patent. Therefore restriction for examination purpose is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication should be directed to Zohreh Fay at telephone number (703) 308-4604.

Fay/LR

March 27, 2002

ZOHREH FAY
PRIMARY EXAMINER
GROUP 1200

